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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,096	05/12/2006	Stefan Kirsch	289264US0PCT	6922
22850	7590	10/24/2007		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER REDDY, KARUNA P	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			10/24/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/579,096	<b>Applicant(s)</b> KIRSCH ET AL.	
	<b>Examiner</b> Karuna P. Reddy	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/17/2007</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to the amendment filed on August 17, 2007.  
Applicants amended claim 10 and added claims 24-25. Claims 1-25 are currently pending in the application.
2. The texts of those sections of Title 35 U.S. Code not included in this action can be found in office action mailed May 23, 2007.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 25 (newly added) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is the examiner's position that this phrase fails to satisfy the written description requirement of 35 USC 112, first paragraph since there does not appear to be a written description requirement of the phrase "substantially all of water-soluble ionic compounds have been removed" in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed. While there is support for removing "preferably at least 90% of the water-soluble ionic compounds" on page 7, line 9 of the specification, there is nothing on the record to indicate a nexus, or any sort of connection, between "at least 90%" and "substantially". The term "substantially" is relative and is not necessarily implied by and does not necessarily flow from "at least 90%".

6. Claim 10 (amended) is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites the limitation of anionic emulsifiers or protective colloids as required water-soluble ionic compounds, while the arguments/remarks point to these ingredients as optional. Therefore, it is not clear as to what controls the metes and bounds of this claim.

***Claim Rejections - 35 USC § 102***

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7. Claims 1-13, 15-18, 20-21, 23; and 25 (newly added) remain rejected under 35 U.S.C. 102(b) as being anticipated by Wood (US 5, 286, 843) as evidenced by Pastorino et al (US 4, 940, 732).

The rejection is adequately set forth in paragraph 3 of office action mailed 5/23/2007.

8. Claims 1-13, 15-18, 20-21, 23; and 25 (newly added) are rejected under 35 U.S.C. 102(b) as being anticipated by Wood (US 5, 536, 811) as evidenced by Pastorino et al (US 4, 940, 732).

The rejection is adequately set forth in paragraph 4 of office action mailed 5/23/2007.

***Claim Rejections - 35 USC § 102/103***

9. Claims 10-20; and 24 (newly added) are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kleiner et al (WO 02/10306 A2).

The rejection is adequately set forth in paragraph 7 of office action mailed 5/23/2007.

***Claim Rejections - 35 USC § 103***

10. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood (US 5, 286, 843) or Wood (US 5, 536, 811) individually, in view of Nakabayashi et al (US 3, 964, 955).

The rejection is adequately set forth in paragraph 8 of office action mailed 5/23/2007.

### ***Response to Arguments***

11. Applicant's arguments filed 8/17/2007 have been fully considered but they are not persuasive. Specifically, applicant argues (A) EP-A-571069 from the same patent family of Wood et al has been cited in the specification as having poor wettability on customary substrates; (B) Wood does not suggest addition of a material such as Emcol® 4500 following deionization; and (C) it is neither anticipated nor obvious to exclude a required component such as tetrasodium (N-dicarboxy-alkyl) N-alkyl sulfosuccinamate from the aqueous polymer dispersion.

With respect to (A), there is no evidence either in specification of the present application or the prior art of Wood to support a mere allegation of poor wettability of the composition of Wood on customary substrates.

With respect to (B), present claims do not specify the order in which water-soluble ionic compound is removed and the salt of monoalkyl or dialkyl ester of sulfonated dicarboxylic acid is added. Examiner gave it the broadest

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interpretation to include all possible scenarios and Wood therefore anticipates the present claims. Even if the order is specified, case law holds that selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results. See *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946). In fact, data in table 1 points to inferior resistance to water-whitening when +1% Lumiten 1-SC is added to aqueous dispersion after diafiltration (see table 1, where the duration of immersion in water is 60 min).

With respect to (C), present claims use the transitional phrase "comprising at least one water-soluble ionic compound" and are open ended to include other ingredients such as tetrasodium (N-dicarboxy-alkyl) N-alkyl sulfosuccinamate.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karuna P. Reddy whose telephone number is (571) 272-6566.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service

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Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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